

### REMARKS

The first page, after the list of inventors but before the "Field of Inventors" of the specification has been amended to incorporate a priority claim.

Page 58, line 6, has also been amended to correct the formalities. This amendment was request by the Examiner.

Claims 28 and 58 have been amended to correct the 112 second paragraph issues identified by the Examiner. Claims 28 and 58 have also been amended to limit disposable articles to diapers.

Claim 34 has been amended to remove the term "effective amount" and replace it with the term "effective concentration". Support for this amendment can be found at page 19 line 22 to page 20 line 3.

Claim 37 has been amended in accordance with the Examiners suggestion.

Claim 42 has been amended to list the components in proper Markush fashion. This amendment was also suggested by the Examiner.

No new matter has been added and no additional claim fee is due. Claims 28-32, 34-37, 40-44, 47-49 and 58-60 are pending in the application after the amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

### Objections

The Examiner has objected to Claim 37, more specifically the second "a" on line 2 of the claim. Applicants, propose to delete the second a to remove this rejection. Consequently, reconsideration and withdrawal of this objection is respectfully requested.

### Rejection under 35 U.S.C. 112 Second paragraph:

The Examiner has rejected Claims 28 and 58 as having multiple terms having insufficient antecedent basis for these limitations. Applicants propose to amend Claims 28 and 58 to remove these antecedent issues identified by the Examiner. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

The Examiner has also rejected Claim 34 as being unclear. Specifically, the Examiner asserts that the term “effective amount” is unclear. Applicants have amended the term “effective amount” to now read “effective concentration”. This term, “effective concentration” can be found at page 19, line 22 to page 20 line 3, where not only is the term defined, but also how to determine it. Consequently, reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner has rejected Claim 42 as using an improper Markush form. Applicants propose to amend Claim 42 to place it in the acceptable Markush form. Consequently, reconsideration and withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. 102:

Claims 28-32, 36, 38-44, 47-48, and 58-59 have been rejected under 35 U.S.C. §102 as being anticipated by Srinivasan et al., US Patent No 3,913,579. It is the Examiner’s contention that Srinivasan anticipates these claims. Applicants respectively traverse the rejection.

Section 2131 of the MPEP states to anticipate a claim, the reference “MUST TEACH EVERY ELEMENT OF THE CLAIM” (emphasis in original). Applicants respectfully submit that all the claim limitations are not taught or suggested by Srinivasan, as shown below.

Applicants submit that Srinivasan does not teach every element of Applicants’ independent claims. In particular, Srinivasan does not teach, disclose, or otherwise suggest a diaper, let alone a diaper incorporating a fecal modifying agent. These claim elements are expressly recited in Applicants’ independent Claims 28 and 58. Therefore, unless and until the Examiner can identify in Srinivasan any teaching of, diapers or diapers incorporating a fecal modifying agent Applicants respectfully submit that the Examiner’s 35 U.S.C. §102(b) rejection should be withdrawn.

Rejection under 35 U.S.C. 103:

Claims 35, 37 and 60 are rejected under 35 U.S.C. §103 as being obvious over Srinivasan et al., US Patent No 3,913,579, in view of Duncan et al US Patent No 3,489,148. It is the Examiners contention that that the claimed disposable

absorbent articles are obvious in light of what is taught by Srinivasan in view of Duncan. Applicants respectively traverse the rejection.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP706.02(j); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Srinivasan relates to flushable sanitary napkins, and is focused on solving the problems associated with a gender specific flushable article for adults. Whereas Duncan is directed to a topsheet for disposable infant diapers. It is unclear to Applicants' what motivation one of ordinary skill would have to combine the teachings of these two. Both Srinivasan and Duncan are in different fields of art. Srinivasan is in a field which flushability and absorbency of a gender specific waste are paramount, contrasted with Duncan which is not flushable and never contemplates any use other than on a child.

Instead, the Examiner is attempting to use the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and *In re Brouwer*, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The teachings from Duncan provide no additional motivation or suggestion to one of ordinary skill to that of Srinivasan. As the Examiner is well aware, any obviousness objections based on a combination of prior art references, such as in the present situation, there must be some teaching, suggestion, or motivation to combine the references. See *In re Rouffet* 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir.1998).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). There is no such teaching, suggestion, or motivation to combine any of the references in the present situation. Duncan provides no motivation for one of ordinary skill to combine its teaching with that of Srinivasan.

In view of the foregoing remarks and the clarifying amendments, it is respectfully requested that rejection of Claim 35, 37 and 60 be reconsidered and withdrawn.

#### Obviousness-Type Double Patenting

In the noted office action, the Examiner has provisionally rejected Claim 49 under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claim 1 of commonly assigned U.S. Patent No. 6,160,198. The Applicants will file a terminal disclaimer upon the indication of allowable subject matter.

#### CONCLUSION

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 28-32, 34-37, 40-44, 47-49 and 58-60 are allowable over the prior art of record or any combination thereof. All of the Examiner's rejections and objections have been addressed. The proposed amendments to the specification and claims do not add new matter and are made merely to help the Examiner understand what would be readily apparent to one of ordinary skill in the art. In the event that any issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned agent to discuss them.

Respectfully submitted,

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

On page 1, before FIELD OF THE INVENTION, please insert

CROSS REFERENCE

This is a continuation-in-part of under 35 U.S.C. §120 of Patent Applications Serial Nos. 09/107,561, filed June 29, 1998; 09/106,225, filed June 29, 1998; and 08/970,508, filed November 14, 1997; claims priority to Provisional Applications Serial Nos. 60/091,076, filed June 29, 1998 and 60/090,993, filed June 29, 1998.

At page 58, line 6, please amend as indicated

As shown in Figures 11 and 12, the diaper 200 also includes an effective amount (about 3.5 grams) of an alginic acid, ammonium-calcium salt composition 190 (Sigma A-7253, available from Sigma Chemical Co., St. Louis, Missouri), described above in connection with Tables VI and VIII as an FMA, applied to a carrier 180. Carrier 180 comprises a wearer-facing fibrous loop material 182 which may be bonded to an optional thermoplastic backing 184 made, for example, from polypropylene. Materials of this nature are described in in PCT Patent Application Serial No. US97/20840 entitled "Disposable Absorbent Article Having Fecal Management Member", filed November 14, 1997, corresponding to U.S. Application Serial No. 09/554,544, filed November 16, 1998 (P&G Case CM1642FQ), which is incorporated herein by reference. The alginic acid, ammonium-calcium salt 190 is releasably affixed to a loop material 182 via hydrogen bonding. Such hydrogen bonding may be obtained by applying a fine water mist to the wearer-facing surface of the loop material, applying the alginic acid, ammonium-calcium salt to the wearer-facing surface, and subsequently drying the structure. Excess or additional alginic acid, ammonium-calcium salt may be disposed in any voids 185 in the loop material 182. Carrier 180 is joined to the wearer-facing surface of the topsheet 24 in at least a portion of the crotch region associated with the wearer's perianal region using adhesive, or any other suitable attachment means or combinations of means such as heat bonds, pressure bonds, ultrasonic bonds, dynamic mechanical bonds. Lotion composition 188 may also be applied to at least a portion of the carrier, such as to the valleys 186 between loops in loop material 182.

In the Claims:

Please amend the claims as follows:

28.(Thrice Amended) A disposable article adapted to be worn by a wearer comprising:

one or more compositions for enhancing [the] removability of fecal waste from [the] skin of the wearer, said one or more compositions being available to at least a portion of one of said fecal waste and said skin of said wearer; wherein said disposable article is a diaper and said one or more compositions provide one or more of the following as determined by the [test] methods set forth in the specification:

a) a Waste Contamination Area of less than about 15 cm<sup>2</sup>;

b) a Waste Contamination Mass calculated from an equation  $\sum_{L0}^{Ln}$  (mArArea X mARGV)/255 of less than about 14 mass units.

34.(Amended) The disposable article of Claim 28 wherein at least one of said compositions comprises an effective [amount] concentration of a feces modifying agent.

37.(Amended) The disposable article of Claims 35 or 36 wherein said skin care composition comprises a material selected from the group consisting of: [a] petroleum oils, petroleum waxes, silicone oils, and silicone waxes.

42.(Amended) The absorbent article of Claim 41 wherein the thickener is selected from the group [including] consisting of: carboxymethyl cellulose, xanthan gum, polyacrylic acid and salts thereof, polyacrylamide, and polyethyleneimines.

58. (Thrice Amended) A method of enhancing [the] removability of bodily waste from [the] skin of a wearer of a disposable article, the method comprising:  
providing a disposable article adapted to be worn by the wearer;

associating one or more compositions for enhancing the removability of fecal waste from the skin of the wearer with said disposable article so that said one or more compositions are available to at least a portion of one of said bodily waste and said skin of said wearer and said disposable article is a diaper; said one or more compositions providing one or more of the following as determined by [the] test methods set forth in the specification:

- a) a Waste Contamination Area of less than about 15 cm<sup>2</sup>;
- b) a Waste Contamination Mass calculated from [the] equation  $\sum_{L0}^{Ln}$  (mArArea X mArGV)/255 of less than about 14 mass unit.